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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

K35A1501

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on 03/30/07

Signature

Typed or printed name Howard H. Sheerin

Application Number

10/816,545

Filed

03/31/2004

First Named Inventor

Barry L. Klein

Art Unit

2115

Examiner

Cao, Chun

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number \_\_\_\_\_

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 37,938

Signature

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303-765-1689

Telephone number

03/30/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: Barry L. Klein

Serial No.: 10/816,545

Filing Date: 03/31/2004

For: REMOTE POWER CYCLING OF  
PERIPHERAL DATA STORAGE SYSTEM

Art Unit: 2115

Examiner: Cao, Chun

Confirmation No.: 1000

Docket No.: K35A1501

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the office action mailed on January 29, 2007, please consider the following pre-appeal brief request for review. A Notice of Appeal has been filed herewith.

**ARGUMENT**

**I. THE ISSUE UNDER 35 U.S.C. §103(a)**

**A. Claims 1-6, 8-19, 21-26, 28-35, and 37-39**

The rejection of these claims should be reversed because the relied upon prior art neither discloses or suggests to power-up a peripheral data storage system in order to perform a host-scheduled backup operation. Regarding claim 1, Chen does not disclose or suggest to transmit data to the peripheral data storage system from the host system based on a host-scheduled backup operation. In response to this argument, the examiner argues that Chen discloses this limitation at paragraphs 0004, 0005, 0016, and 0020. The applicant respectfully disagrees.

At paragraph 0004, Chen merely discloses the use of a disk server for providing file management functions.

At paragraph 0005, Chen merely discloses to “set an appropriate schedule for performing the system maintenance”. However, “system maintenance” refers to the maintenance of the disk server rather than to the maintenance of the host system, let alone the backing up of data stored at the host system.

At paragraph 0016, Chen merely discloses a server management system shown in Fig. 1 including a network server 110 and storage server 120 which allows users to transmit files in sequential order and alter data transmission sequences of the files upon user's requests.

At paragraph 0020, Chen merely discloses that “a scheduling command is provided for the user to input pre-arranged task schedules”. However, Chen does not disclose or suggest that the pre-arranged task schedules include a backup operation of data stored at the host system.

In short, Chen does not disclose or teach a host-scheduled backup operation. The Examiner even concedes that “Chen does not explicitly teach of transmitting pre-selected data to the peripheral data storage system from the host system.” (Final Office Action at page 3) Because a backup operation requires the transmission of pre-selected data, this statement confirms that Chen does not disclose a backup operation.

The examiner takes official notice that a backup operation is well known in the art, including AAPA described at paragraph 3 of applicant's specification. However, the prior art (including the AAPA) does not disclose or suggest that the backup operation be performed on a schedule **by powering up the storage system before backup or powering down the storage system after backup**. In contrast, paragraph 3 of the specification describes how the peripheral data storage system is generally left in the ON state at all times in the AAPA:

“in current products, however, even though a host system performs a scheduled backup operation to a external peripheral data storage system at a pre-selected time(s), the external peripheral data storage system is **often kept in**

**an ON state by a user at all times** to reduce the occurrence of an OFF state of the external peripheral data storage system during a scheduled backup time, particularly if the backup is scheduled for a time when the user is unavailable to return the peripheral data storage system to an ON state. As such, **the external peripheral data storage systems are left in an ON state for longer than necessary**, resulting in inefficient power usage and reducing the overall longevity of the external peripheral data storage system.”

Accordingly, the AAPA discloses that in current products the storage system is left on to ensure that backup operations can occur on schedule, and nothing in Chen discloses or suggests to power-up/power-down a storage system in order to perform a scheduled backup operation of the host system. The rejection should therefore be reversed. Independent claims 21, 38, and 39 are patentable for the same reasons. Consequently, claims 1-6, 8-19, 21-2, 28-35, and 37-39 should be allowed.

B. Claims 7 and 27

The rejection of these claims should be reversed because these claims depend from allowable independent claims as discussed above. In addition, these claims (and claim 32, which depends from claim 27) are allowable because the relied upon prior art neither discloses or suggests to determine if the transmitted pre-selected data were stored in the peripheral data storage system prior to the powering-down the peripheral storage system. Regarding claim 7, the examiner concedes that neither Chen or the AAPA teach to determine if the transmitted pre-selected data were stored in the peripheral data storage system prior to the powering-down the peripheral storage system. The examiner asserts this limitation is very well known in the computer art, including Blasco (col. 2, lines 1-5, 25-31). The applicant respectfully disagrees.

The “determining” limitation recited in claim 7 is not well known in the prior art. As described above, Chen and AAPA do not disclose or suggest to power-up/power-down a storage system in order to perform a backup operation of the host system.

Therefore, the “determining” limitation recited in claim 7 cannot be well known in the prior art because the prior art does not disclose to power-down the storage system after completing a backup operation.

In addition, nothing in Chen, Blasco, or the AAPA suggest a motivation for modifying the prior art to arrive at the claimed invention. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” See *In re Fritch*, 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).

Indeed, combining the teachings of Blasco with Chen would render the device in Chen inoperable, which teaches away from the claimed invention. Blasco teaches to power-down the system – i.e., the storage device **and** the host system – after completing the backup operation (see FIG. 1; col. 2, lines 25-31). If the storage device and the host system in Chen – i.e., network server 110 and storage server 120 – were powered-down according to Blasco, Chen would not be able to perform a scheduled backup operation (assuming for the sake of argument that Chen discloses a scheduled backup operation). Specifically, after the host in Chen was powered-down according to Blasco, it could not power itself up again according to a scheduled backup operation, which would also prevent the host from powering-up the storage device. See Chen at paragraphs 29-31. Because it would result in an inoperative device, combining Blasco and Chen teaches away from the claimed invention. See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (“If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.”) (citations omitted).

Moreover, if Blasco were combined with Chen, the host in Chen would be prevented from “allow[ing] the remote terminal device 300 to perform data access according to user’s commands and requirements” (Chen at paragraph 16) and from

receiving "management information sent by the user via a remote terminal device 300" (Chen at paragraph 19). Consequently, combining Blasco with Chen would render Chen unsuitable for its intended purpose, which is improper. See MPEP 2143.01, Section V ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.") (citation omitted); MPEP 2145, Section X.D.

The rejection should therefore be reversed for claims 7 and 27 (and for claim 32, which depends from claim 27) for these additional reasons.

#### CONCLUSION

Withdrawal of the rejections is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 23-1209, and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: 3/30/07

By: Howard H. Sheerin  
Howard H Sheerin, Esq  
Registration No. 37,938

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

3/30/07 Howard H. Sheerin  
(Date) (Print Name)

Howard H. Sheerin  
(Signature)